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J. Alexander Marchosky

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EXAMINER

NGUYEN, HIEP VAN

ART UNIT

PAPER NUMBER

3686

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/729,082	<b>Applicant(s)</b> MARCHOSKY, J. ALEXANDER	
	<b>Examiner</b> HIEP NGUYEN	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 January 1937 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/23/2009, 02/18/2008, 11/22/2006, 03/14/2006,</u>           | 6) <input type="checkbox"/> Other: _____                          |
| <u>12/05/2003.</u>   |   |



### **DETAILED ACTION**

1. Claims 1-37 have been examined.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 35-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 35 is directed to a method for delivering healthcare. Claim 35 recites determining healthcare eligibility, establishing rules... (emphasis added). However, this is merely software, and it has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

Claim 36 is rejected as it depends from Claim 35.

5. Claim 37 is directed to a healthcare process. Claim 37 recites "inputting medical and biographical data, reporting any inaccuracies, authorizing certain health care..." (emphasis added). However, this is merely software, and it has been held that software

without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112, Second Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term "eligibility" in claim 35 is a relative term which renders the claim indefinite. The term "eligibility" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 36 is rejected as it depends from Claim 35.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 8-11, 15-27, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US PGPub. 20010041991) in view of Lavin et al. (US 5,772,585.)

11. With respect to Claim 1, Segal et al. teaches a medical records system comprising:

a central computer ('991; Para 0072) connected to a global computer network having a medical records database thereon, said database containing individual medical records of a plurality of patients, each of said records corresponding to one patient of said plurality of patients ('991; Fig 1: clinical database; Para 0026: creating a file in the clinical database to accept medical record information);

a patient computer connected to the global network remote from the central computer having a patient interface program adapted to permit a patient to input medical history and biographical information ('991; Para 0023) into the medical records database and to authorize a health care professional to access at least a portion of the

individual medical records of the respective patient ('991; Fig. 1: plurality of patients' computer connecting the internet);

a health care computer connected to the global network remote from the central computer having a health care professional interface program ('991; Para 0082-0083; Fig 1: plurality of referral and primary physicians' computers connecting to the internet).

Segal et al. does not explicitly disclose the medical records system having an authorized health care professional to access the portion of the individual medical records for which the health care professional has authorization and to input additional patient medical history and biographical information into the corresponding individual medical record of the database.

Lavin et al. discloses an authorized health care professional to access the portion of the individual medical records for which the health care professional has authorization and to input additional patient medical history and biographical information into the corresponding individual medical record of the database ('585; col./Line 8/60-9/8; lines 58-60; Col. /line 10/59-11/29.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the system of Segal et al. for providing patient medical records ('991; Abstract) the improvement of physician access of recordal examination as taught by Lavini et al. ('585; Abstract) for updating patient data.

12. With respect to Claim 2, the combined art teaches a records system as set forth in claim 1. Lavin et al. discloses wherein the health care professional interface program is adapted to permit an authorized health care professional to input information into the corresponding individual medical record of the database, said information being selected from a group consisting of social history, clinical findings, laboratory test results, imaging results, physiologic findings, biochemical findings, anatomic findings, psychological findings, psychiatric findings, pathological findings, genetic findings and phenotypic findings ('585; Col. 9, lines 8-18).

Claim 21 is rejected as the same reason with Claim 2.

13. With respect to Claim 3, the combined art teaches a records system as set forth in claim 1. Lavin et al. discloses wherein the health care professional interface program is adapted to permit an authorized health care professional to input information into the corresponding individual medical record of the database, said information being selected from a group consisting of diagnosis, conclusions, recommendations, treatments, procedures and outcomes ('585; Col. 10/59-11/29.)

14. With respect to Claim 4, the combined art teaches a records system as set forth in claim 1. Lavin et al. discloses wherein the health care computer includes a health



care reference database containing information selected from a group consisting of diagnostic and protocol data, toxicology data, allergy data, immunological data, developmental data, endocrine data, cardiovascular data, gastrointestinal data, respiratory data, renal data, reproductive data, musculoskeletal data, rheumatologic data, dermatologic data, otorhynolaryngologic data, ophthalmologic data, gynecologic data, urologic data, neurological data, psychological data, psychiatric data, hepatologic data, homological data, pediatric data, rehabilitative data, genetic data and phenotypic data ('585; Col. 13, lines 29-59: list of IC 9 and various procedures CPT 95).

15. With respect to Claim 8, the combined art teaches a records system as set forth in claim 1. Segal et al. discloses wherein at least one of said individual medical records is stored in the database as an electronic document image in a lossless compression format ('991; Para 0122).

16. With respect to Claim 9, the combined art teaches a records system as set forth in claim 1. Lavin et al. discloses wherein the health care computer includes a security program adapted to selectively limit an extent and type of information stored in the individual medical records based on a degree of confidentiality assigned by a health care provider to the medical record for limiting access to the information by the health care professionals ('585; Col. 5, lines 36-47).

17. With respect to Claim 10, the combined art teaches a records system as set forth in claim 9. Lavin et al. discloses wherein the security program identifies and logs each attempt to access records in the medical records database ('585; Col. 5, lines 36-47).

Claim 25 is rejected as the same reason with Claim 10.

18. With respect to Claim 11, the combined art teaches a records system as set forth in claim 9. Lavin et al. discloses wherein the security program identifies and logs the patients and the health care professionals who enter and store new information in the medical records database ('585; col./line 8/59-9/18).

Claim 24 is rejected as the same reason with Claim 11.

19. With respect to Claim 15, the combined art teaches a records system as set forth in claim 12. Segal et al. discloses further comprising a scanner for creating the document image from a source document ('991; Para 0027).

20. With respect to Claim 16, the combined art teaches a records system as set forth in claim 12. Segal et al. discloses wherein the document image further comprises an encrypted digital watermark embedded in a blank space of the image and providing information about the image ('991; Paras 0076-0077; 0127).

21. With respect to Claim 17, the combined art teaches a records system as set forth in claim 12. Segal et al. discloses wherein the information provided about the document image is selected from a group consisting of information about document ownership, origin, source, subject matter, and information about access rights ('991; Paras 0121, 0122).

22. With respect to Claim 18, the combined art teaches a records system as set forth in claim 12. Segal et al. discloses wherein the document image is stored in a lossless compression format ('991; Para 0122).

23. With respect to Claim 19, the combined art teaches a records system as set forth in claim 1. Lavin et al. discloses where at least one of the central computer and the health care computer includes a program adapted to integrate the user and provider information to perform at least one of authorizing recommended prescriptions, prescribing treatments, prescribing therapies, prescribing interventions, ordering laboratory tests, ordering imaging and performing studies ('585; Col./line 13/60-14/36).

Claim 29 is rejected as the same reason with Claim 19.

24. Claim 20 is rejected as the same reason with claim 1.

25. With respect to Claim 22, the combined art teaches a method as set forth in claim 21. Segal et al. discloses wherein record modification is logged ('991; Para 0113).

26. With respect to Claim 23, the combined art teaches a method as set forth in claim 21. Segal et al. discloses wherein copies of previous records are retained when a record is modified ('991; Para 0113).

27. With respect to Claim 26, the combined art teaches a method as set forth in claim 20 further comprising permitting a payer approved by the particular patient to access the record of the particular patient to verify treatment ('585; Col. 7, lines 25-45).

28. With respect to Claim 27, the combined art teaches a method as set forth in claim 20. Lavin et al. discloses further comprising analyzing the record of at least one of said plurality of patients to determine whether the record is extraordinary compared to the records of other patients within said plurality of patients ('585; Col. 11, lines 61-66).

29. With respect to Claim 30, the combined art teaches a method as set forth in claim 20. Segal et al. discloses further comprising authorizing payment of services upon satisfaction of established parameters for services ('991; Para 0154).

30. With respect to Claim 31, the combined art teaches a method as set forth in claim 20 wherein permission to access information contained in the records is variable and depends on established parameters ('991; Para 0138).

31. With respect to Claim 32, Segal et al. teaches a method for providing health care services to a plurality of patients comprising:

establishing rules for delivering and receiving health care services ('991; Para 0072);

acquiring individual medical records from each patient of the plurality of patients ('991; Fig 1: clinical database; Para 0026: creating a file in the clinical database to accept medical record information);

requiring a particular patient of said plurality of patients to update the medical record by inputting current information, storing said records obtained from the particular patient in a database on a central computer (991; Fig. 1: plurality of patients' computer connecting the internet).

Segal et al. does not disclose explicitly requiring authorization from the particular patient to grant a health care professional access to at least a portion of the corresponding individual medical record of that particular patient prior to receiving health care services from the health care professional, nor requiring the authorized health care professional to review the portion of the record in the database corresponding to the particular patient prior to the rendering of health care services

Lavin et al. discloses requiring authorization from the particular patient to grant a health care professional access to at least a portion of the corresponding individual medical record of that particular patient prior to receiving health care services from the health care professional (585; col./Line 8/60-9/8; lines 58-60; Col. /line 10/59-11/29), and requiring the authorized health care professional to review the portion of the record in the database corresponding to the particular patient prior to the rendering of health care services, and requiring the authorized health care professional to provide an accurate record of the health care services rendered ('585; Col. 9, lines 9-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the system of Segal et al. for providing patient medical records ('991; Abstract) the improvement of physician access of recordal examination as taught by Lavini et al. ('585; Abstract) for updating patient data.

32. With respect to Claim 33, the combined art teaches a method as set forth in claim 32 further comprising authorizing payment of services only when the health care professional follows the established rules for delivering health care services ('585; Col. 7, lines 25-45).

33. With respect to Claim 34, the combined art teaches a method as set forth in Claim 32. Lavin et al. discloses further comprising authorizing payment of services only

when the particular patient follows the established rules for delivering health care services ('585; Col. 7, lines 25-45).

34. Claims 5-7, 12-14, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US PGPub. 20010041991) in view of Lavin et al. (US 5,772,585.) and further in view of Rice et al. (US PGPub. 20020049614.)

35. With respect to Claim 5, the combined art does not disclose, according to a records system as set forth in claim 1. wherein at least one of said individual medical records includes a watermark providing information about the record.

However, Rice et al. discloses wherein at least one of said individual medical records includes a watermark providing information about the record ('614; Abstract)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the system of Segal et al. /Lavin et al. for providing patient medical records ('991; Abstract) with the physician access of recordal examination ('585; Abstract) and the system of Rice et al. related to watermarked electronic image signature to authenticate the documents ('614; Abstract).

36. With respect to Claim 6, the combined art Segal et al./Lavin et al./Rice et al. teaches a records system as set forth in claim 5. Rice et al. discloses wherein said watermark comprises a bit encrypted two dimensional bar code including information selected from a group consisting of ownership information, information related to source, information related to origin, information related to subject matter, and information related to access rights of the associated record ('614; Para 0019).

Claim 28 is rejected as the same reason with Claim 6.

37. With respect to Claim 7, the combined art Segal et al./Lavin et al./Rice et al. teaches a records system as set forth in claim 5 wherein said central computer includes a central program adapted to analyze watermarks of individual medical records containing information selected from a group consisting of record content, source, and specific data, and to index the record for re-distribution and display ('614; Para 0023).

38. With respect to Claim 12, the combined art Segal et al./Lavin et al. does not teach, according to a records system as set forth in claim 1, wherein said medical records database includes a document image having an encrypted visual watermark thereon providing information about the document image.



However, Rice et al. discloses wherein said medical records database includes a document image having an encrypted visual watermark thereon providing information about the document image ('614; Para 0028).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the system of Segal et al. /Lavin et al. for providing patient medical records ('991; Abstract) with the physician access of recordal examination ('585; Abstract) and the system of Rice et al. related to watermarked electronic image signature to authenticate the documents ('614; Abstract).

39. With respect to Claim 13, the combined art teaches a records system as set forth in claim 12. wherein the information provided about the document image includes information selected from a group consisting of document ownership, origin, source, subject matter, and management of access rights ('614; Para 0027).

40. With respect to Claim 14, the combined art Segal et al./Lavin et al./Rice et al. teaches a records system as set forth in claim 12. Rice et al. discloses wherein the document image includes a bar code having at least bits of encrypted data arranged in two dimensions ('614, Para 0019).

41. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US PGPub. 20010041991) in view of Mahmud et al. (US PGPub. 20010032100).

42. With respect to Claim 35, Segal et al. teaches a method for delivering health care while controlling interaction between users, providers and payers through parameters and rules comprising:

determining health care service user eligibility, determining health care service provider eligibility ('991; Fig. 1);

establishing rules for the administration of the health care service system ('991; Para 0096);

determining reasonable costs for health care products and services; determining health care services that will be paid by the administrator or a third party, dispersing payment to health care service providers ('991; Para 104);

ensuring availability of health care services ('991; Para 0112);

eliminating unnecessary use and abuse of health care services ('991; Para 0112);

Segal et al. does not disclose explicitly guiding development of future services; monitoring health care service users' compliance with established rules of the health care service system, monitoring health care service providers' compliance with established rules of the health care system, enforcing all rules of the health care service system.

However, Mahmud et al. discloses guiding development of future services; monitoring health care service users' compliance with established rules of the health care service system; monitoring health care service providers' compliance with established rules of the health care system; enforcing all rules of the health care service system ('100; Para 0024; 0026; 0030)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the system of Segal et al. /Lavin et al. for providing patient medical records ('991; Abstract) the user authorization protocol to protect the confidentiality of patient records ('100; Abstract)

43. With respect to Claim 36, the combined art teaches a method as set forth in claim 35. Segal et al. discloses further comprising assessing reasonable fees to health care service users ('991; Para 0024).

44. Claim 37 is rejected as the same reason with Claim 35.

***Conclusion***

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571) 270-5211. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/H. N./  
Examiner, Art Unit 3686  
April 9, 2009

/Gerald J. O'Connor/  
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